

REMARKS

In the Office Action, the Examiner rejected claims 1-24. In this Amendment and Response, Applicants amended claims 1 and 10 to clarify certain features of the instant claims. These amendments do not add any new matter. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of pending claims 1-24.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected independent claim 1 under 35 U.S.C. § 102(b) as being anticipated by Braithwaite et al. (U.S. Patent No. 6,104,561). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of

anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features Omitted from Braithwaite

Independent claim 1, as amended, recites “interacting with the computer diskette to produce a failure code indicative of a *position of a write protect mechanism disposed on the computer diskette.*” In sharp contrast, the Braithwaite et al. reference never mentions a write protect mechanism disposed on a diskette. Indeed, as illustrated in Figure 3 and discussed in the associated text, the cited reference describes the various parts of a floppy diskette, but never discloses a mechanical device on the diskette which may be utilized to provide for write protection of the diskette. *See* col. 4, lines 30-48. It is not surprising that the Braithwaite et al. reference fails to disclose such a mechanism (e.g., an aperture and a slider). After all, the reference is directed to electronic means for protecting the diskette, as opposed to a mechanical approach of write protection, as claimed. *See, e.g.*, Braithwaite, col. 5, lines 14-62. Thus, the Braithwaite et al. reference fails to disclose each element of independent claim 1, and therefore, it cannot anticipate claim 1 or the claims dependent thereon. For at least this reason, Applicants request withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of claim 1.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected: claims 1, 3, 4, 6-8, 10, and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Wambach et al. (US 6,330,648) in view of Braithwaite et al.; claims 1, 10, 18, 19 and 22-24 under 35 U.S.C. 103(a) as being unpatentable over MacLeod (US 6,598,135) in view of Braithwaite et al.; claims 2, 5, 9, and

11-13 under U.S.C. 103(a) as being unpatentable over Wambach et al. in view of Braithwaite et al. and MacLeod; claims 20 and 21 under 35 U.S. C. 103(a) as being unpatentable over MacLeod in view of Braithwaite et al. and Wambach et al. Claims 1, 10, and 18 are independent. Applicants respectfully traverse these rejections.

Legal Precedent

When construing claims, the Federal Circuit has consistently looked to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002):

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

Additionally, Applicants remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition

in the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Furthermore, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the modification or combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

Similarly, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-*

Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, 994 F.3d 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Claim Features Omitted from Independent Claim 1

Independent claim 1 recites “a failure code based on a *position* of a write protect mechanism disposed on the computer diskette.” As discussed above, the Braithwaite et al. reference does not disclose such a mechanism. Similarly, the Wambach et al., and MacLeod references also fail to disclose a “failure code based on a *position* of a write-protect mechanism,” as recited in claim 1. Instead, all three references are directed to an *electronic* means for protecting their respective media devices. *See, e.g.*, Braithwaite et al., col. 5, lines 15-26 (explaining that codes descriptive of protect modes are electronically stored); Wambach et al., col. 4, lines 1-20 (noting that a microprocessor or logic circuit carries out the write protect function based on a stored list of “protected” mass memory locations); MacLeod, col. 3, lines 1-11 (explaining that the MacLeod et al invention utilizes write protect flags). The Applicants note that an embodiment of the claimed write-protect mechanism in the present application includes a “write-protect tab” and a “write-protect notch,” which may be defined as a:

small opening in the jacket of a floppy disk that can be used to make the disk unwritable. On a 5.25-inch floppy disk, the write-protect notch is a rectangular hole on the edge of the disk

jacket. When this notch is covered, a computer can read from the disk but cannot record new information on it. On 3.5-inch micro-floppy disks . . . the write-protect notch is an opening in a corner. When the sliding tab in this opening is moved to uncover a small hole, the disk is protected and cannot be written to.

MICROSOFT COMPUTER DICTIONARY 576 (5th ed. 2002). It is clear that the cited references, taken alone or in combination, do not disclose a write protect mechanism (e.g., slider and aperture, write-protect tab, write-protect notch, etc.) disposed on the computer diskette, and thus cannot support the foregoing rejections of independent claim 1, and the claims dependent thereon.

Claim Features Omitted from Independent Claim 10

Independent claim 10, as amended, recites “seeking to a location *beyond storage tracks and sectors* of a storage area of the floppy disk . . . [and] attempting to write data to the floppy disk at the location.”

In sharp contrast, the three references cited by the Examiner do not disclose any techniques that seek to a location beyond a storage area, or that attempt to write data to such a location. Instead, the Braithwaite et al. reference discloses techniques for determining the write protect status via a stored list of codes. *See, e.g.*, Braithwaite et al., col. 2, lines 43-61. In the Wambach et al. reference, the disclosed techniques determine the write protect status of the Wambach et al. media (a hard disk) by either referencing a list of protected mass memory locations or by detecting a certain flag value of a sector bit. *See, e.g.*, Wambach et al., col. 2, lines 4-16. As for the MacLeod reference, the disclosed technique uses a write protect flag to indicate the protection status of the MacLeod media (a DVD), with absolutely no mention of

attempting to write to a location beyond a storage area. *See, e.g.,* MacLeod, col. 6, lines 14-23. Accordingly, the cited references, taken alone or in combination, do not support the foregoing rejections of independent claim 10 or the claims dependent thereon.

Applicants further emphasize that the Examiner appears confused as to the ordinary and customary meaning in the art of the claim feature “storage area” employed in claim 1. The Applicants note that a storage area includes a “storage location,” which may be defined as “[t]he position at which a particular item can be found – either an addressed location or a uniquely identified location on a disk, tape, or similar medium.” *See* MICROSOFT COMPUTER DICTIONARY 499 (5th ed. 2002). In conflict with this plain meaning, for example, the Examiner implied that because a written sector of the MacLeod DVD cannot be overwritten, the written sector is not a storage area and, therefore, is beyond a storage area. *See* Paper No. 9, page 12. Thus, the Examiner reasons, incorrectly, that the MacLeod technique of attempting to write to the written sector is the same as the presently claimed technique of seeking and attempting to write to a location beyond a storage area. *See id.* (citing MacLeod, col. 6, lines 14-23). However, the Examiner’s interpretation of the claim feature “storage area” is clearly misplaced. Applicants emphasize that both the written sectors and the empty sectors disclosed in MacLeod are indeed storage areas of the MacLeod DVD. In particular, the MacLeod written sector referred to by the Examiner, whether rewritable or not, *stores* data or information and is undeniably *a storage area* of the MacLeod DVD.

In conclusion with regard to claim 10, Applicants stress that the MacLeod reference, as well as the other cited references, do not disclose seeking and attempting to write to a location beyond a storage area, as claimed. For example, the references never mention

seeking or attempting to write to a location beyond storage track and sectors, such as to an address that does not exist, and so on. Therefore, Applicants strongly reiterate that the cited references, taken alone or in combination, do not support the foregoing rejections of independent claim 10 or the claims dependent thereon.

Claim Features Omitted from Independent Claim 18

Independent claim 18 recites “reading data from the computer diskette at a storage location; attempting to write the data back to the computer diskette.” In sharp contrast, the Braithwaite et al. and MacLeod references, taken alone or in combination, absolutely fail to mention or suggest reading data from a location and writing the same data back to the same location. While protection data may be read from special tracks in the Braithwaite et al. system, the system only *examines* the data and clearly does not *write* the data back to the tracks. *See* col. 9, lines 52-67; and Figure 6A. In the Wambach system, a central processing unit retrieves data (protection information) from mass memory and may allow *different* data from *other* sources to be written to the hard drive. *See* Wambach, col. 6, lines 21-35; col. 7, lines 37-48; Figures 3 and 6. It is clear that the Wambach system does not read and write data back to the same location, as claimed. Accordingly, these two references, taken alone or in combination, do not support the foregoing rejection of independent claim 18 or the claims dependent thereon.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the foregoing rejections and allowance of the claims.

No Reason to Combine References

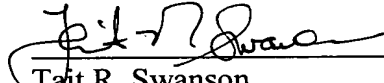
Finally, Applicants stress that there is no suggestion or motivation to combine the three cited references in the manner asserted by the Examiner or in the manner recited in the claims. Thus, it is not surprising that the Examiner has not shown the requisite motivation or suggestion to combine the cited references. Applicants remind the Examiner, as stated in the foregoing legal precedent, it is improper for the Examiner to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, Applicants stress that the Examiner made conclusory and subjective speculation in modifying the Braithwaite et al. reference in an effort to reach the presently claimed techniques. Thus, the Examiner has not met the evidentiary requirements, i.e., objective evidence, for the requisite motivation or suggestion to modify and combine the cited references. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or in the alternative, withdraw the rejections.

Conclusion

In view of the Amendments and Remarks set forth above, the Applicants respectfully assert that the pending claims 1-24 are in condition for allowance. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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